

REMARKS

Claims 1-2, 4-12, and 14 are pending in this application. Claims 1, 6, and 11 are independent. In light of the remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1, 2, 5-8, and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over You et al. (USP 5,946,046) in view of Amo et al. (USP 6,250,428); and rejected claims 4, 9, and 14 under 35 U.S.C. § 103(a) as being unpatentable over You et al. in view of Minolta Camera (JP 2001-100702). Applicant respectfully traverses these rejections.

**Claim Rejections - 35 U.S.C. § 103 -
You et al./Amo et al.**

In support of the Examiner's rejection of claim 1, the Examiner admits that You et al. fails to teach or suggest second information being advertising information. The Examiner relies on Amo et al. to disclose an information display system wherein advertising information is shown on a different section of a display, citing to Fig. 6 and col. 5, line 32 - col. 6, line 5. The Examiner concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to combine You et al. with Amo et al.'s information display device because by doing so,

customized advertising information, as disclosed by *Amo et al.*, could be substituted for captions.

In order to sustain a rejection under 35 U.S.C. § 103(a), it
② is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

③ At the outset, it is respectfully submitted that the Examiner has failed to provide proper motivation in combining the teachings of these references. In support of the Examiner's rejection, the Examiner concludes it would have been obvious to one of ordinary skill in the art to combine the teaching of *You et al.* with *Amo et al.*'s information display device by merely noting that customized advertising information could be substituted for captions. It is respectfully submitted that the motivation provided by the Examiner is found neither in the *You et al.* reference nor in the *Amo et al.* reference. In order to sustain a rejection of the claims under 35

U.S.C. § 103, the Examiner must provide proper motivation in combining the teachings of the references to teach the claimed invention. As neither of the references provide the motivation as asserted by the Examiner, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to combine the teachings of *Amo et al.* with the teachings of *You et al.* Based upon the Examiner's failure to provide proper motivation, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

In addition to the above, it is respectfully submitted that one of ordinary skill would not be motivated to combine the teachings of *Amo et al.* with the teachings of *You et al.* The disclosure as set forth in *You et al.* is directed to a caption processing device and method for a display unit with a separate display. As disclosed in *You et al.*, caption data is extracted from a composite video signal containing a video signal and the caption data. *You et al.* teaches at col. 3, lines 47-57, as follows:

According to FIG. 3, a caption VCR according to a preferred embodiment which reproduces the composite video signal recorded on a video tape, extracts caption data from the reproduced composite video signal through a caption data processor 51, and displays the composite video signal and the caption data, includes a switching

unit 52, mixer 53, monitor 54, LCD driving circuit 55, LCD 57, a microcomputer 58, and an OSD driving unit 63.

A caption data processor 51 receives a composite video signal reproduce[d] from a video tape, and extracts and outputs caption data from the reproduced composite video signal.

As can be seen from the above citation, the video signal and the caption data are mutually related pieces of information.

In contrast, the disclosure as set forth in *Amo et al.* is directed to an information display system that provides for easily updating displays in a system such that information composed in a centralized location may be easily presented at displays located in elevator cabs and waiting areas (col. 2, lines 34-41). The system provides individual servers 220 within a building which are individually and uniquely addressable allowing common information to be received by all buildings and additionally the ability to add additional individualized information relating to a specific building to the general information content (col. 4, lines 17-22).

The control center includes a system server computer 410 for gathering information pages for transmission to various building servers, the information pages including traffic reports, subway or train schedule updates, etc. As building servers are individually addressable from the system server, the specific information destined for the requisite buildings may be communicated to their

respective displays without affecting the information being displayed on other buildings. As the displays are individually addressable, advertising, information, and scheduling updates are addressed to specific displays only when and where appropriate (col. 5, lines 12-31).

As the information and the advertisement information are received from different sources, these two types of information are unrelated. As such, one of ordinary skill in the art would not be motivated to replace the caption information of You et al. with the advertisement information of Amo et al. As such, it is respectfully submitted that one of ordinary skill in the art would not be motivated to combine the teachings of these two references. Based upon the Examiner's failure to provide properly combinable references, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2 and 4-5 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

With regard to the Examiner's rejection of claim 6, the Examiner asserts that You et al. teaches a plurality of second information display units successively displaying a second

information stored, citing to col. 2, lines 39-58. Applicant respectfully disagrees with the Examiner's characterization of this reference.

It is respectfully submitted that You et al. teaches at col. 2, lines 39-58, as follows:

To accomplish the above-mentioned objects, a preferred embodiment of a caption processing device for a display unit with a separate display according to the present invention is provided, the display unit extracts caption data from a video signal and displays the caption, the device includes the separate display for displaying the caption separate from the video signal, a control part for generating a control signal which can control display of the caption data, and a display driving part for receiving the caption data, processing the caption data according to the control signal from the control part and applying the processed data to the display.

In addition, in order to accomplish the above-mentioned objects, a caption processing method for a display unit with a separate display according to the present invention is provided, including a signal separation step for separating caption data from a video signal, a processing step for processing the caption data into data to be used for display, and a display step for displaying the processed caption data on a display which does not make the caption data to overlap on the video signal.

In contrast, the present invention as set forth in claim 6 recites, *inter alia*, an information display device comprising a plurality of second-information display units successively displaying said second information stored. It is respectfully submitted that You et al., as noted above, discloses a separate

display for displaying the caption separate from the video signal. However, it is respectfully submitted that *You et al.* fails to teach a plurality of second-information display units successively displaying the second information stored. There is no teaching or suggestion in *You et al.* that teaches displaying the caption information in two areas successively. As disclosed in *You et al.*, the caption information may be displayed either in display device 57 or display area 220. However, there is no teaching or suggestion that these two display areas may display second information successively. It is respectfully submitted that *Amo et al.* fails to cure the deficiencies of the teachings of *You et al.* as *Amo et al.* fails to teach or suggest a plurality of second-information display units successively displaying a second information stored, assuming these references are combinable, which Applicant does not admit. As such, it is respectfully submitted that claim 6 is not obvious over *You et al.* in view of *Amo et al.*

It is respectfully submitted that claims 7-10 are allowable for the reasons set forth above with regard to claim 6 at least based upon their dependency on claim 6.

It is respectfully submitted that claim 11 contains elements similar to those discussed above with regard to claim 1 and, thus, claim 11, together with claims dependent thereon, is not obvious over *You et al.* in view of *Amo et al.*

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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